



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,512	10/25/2002	Carl Michael Dennison	BLD920010033	2133

25299 7590 05/20/2003

IBM CORPORATION  
PO BOX 12195  
DEPT 9CCA, BLDG 002  
RESEARCH TRIANGLE PARK, NC 27709

EXAMINER

BEATTY, ROBERT B

ART UNIT

PAPER NUMBER

2852

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

10/065,512

Applicant(s)

DENNISON ET AL.

Examin r

Robert Beatty

Art Unit

2852

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

1. The drawings are objected to because the boxes in Fig.1 should be labeled. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires when new claims are presented, they must be numbered consecutively.

The original claims have not been numbered. For purposes of examination, the examiner has consecutively numbered the claims 1-15 however, the applicant should send in a clean copy of the claims (or the amended version of the claims) such that each starts with a claim number. It is to be noted that the designation "[c1]", "[c2]", etc. is not proper claim numbering.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schilekelmann et al. (EPA# 864,933) in view of Nakagiri et al. (EP# 1,098,266).

Schilekelmann et al. teach a reproduction apparatus having an image data

---

input means such as scanning means 2902 or external machine 2910 which are stored in a memory means 2903, a display means 2907, a printing means 2904 for printing the images onto paper sheets, and a control means (having computer readable storage medium) 2905 for controlling all aspects of the reproduction apparatus via instructional operation. See Fig. 29. Referring to Fig.10, a display screen 210 (which is part of the display means 2907) displays a sequence of pages 1012 present in a print job. An indicator symbol 1011 can be moved through the sequence of pages to a desired point and a sheet can be inserted at that point. A blank sheet can be added via button 1007, an intermediate sheet can be added via button 1105 (Fig.11), or a page in the sequence of pages can be deleted via button 1008. As shown, page 21 has been marked such that this sheet was added or is marked for deletion. In addition, a series of pages can be marked. If the print job had already been scanned, reduced versions of these pages can be displayed. An enlarged version of a selected page can be viewed on another part of the display. See col. 10, line 15 – col.11, line 5. The reproduction apparatus will print the print job as modified by the display. As seen Fig.3, the option of inserting a cover sheet in the back or front of the print job can be selected via button 303. The control means 2905 will perform instructions so as to perform a copy operation. Specifically, Schilekelmann et al. teach everything claimed except actually displaying the insert

sheet or a cover (preprinted) sheet in plurality along with the print sheets of the print job on the display means.

Nakagiri et al. teach a reproduction apparatus for printing a print job composed of a plurality of print sheets and of inserting either cover sheets or inserts into the middle of the print job. These print sheets will be displayed on a display means. As seen in Fig.35, for example, the cover sheet can be displayed along with the print job sheets. Additionally, insert sheets that are inserted into the middle of the print job can be displayed as well (see col. 35, lines 15-25). It would have been obvious to one of ordinary skill in the art at the time the invention was made to display inserted cover sheets or inserted middle sheets in a print job because visual confirmation of the output result can be obtained before committing to an actual print operation. It would have been further obvious to one of ordinary skill in the art at the time the invention was made to display the insert sheets in plurality since the need for a printjob having both a cover sheet and a middle insert sheet is encompassed by the operation of both the Schilekelmann et al. and Nakagiri devices and such display would again ease the operator's mind via visual confirmation before committing to an actual print operation.

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 2852

Ohtsuka et al., Osari et al., Glass et al., and Perkins et al. all teach various reproduction apparatus for inserting sheets into a print job and a display to control such operation.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Beatty whose telephone number is 703-308-1372. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Arthur Grimley, can be reached on (703) 308-1373. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9318 (before final) and 703-872-9319 (after final).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.



Robert Beatty  
Primary Examiner  
Art Unit 2852

May 15, 2003